

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant(s): Dupont et al.
Appl. No.: 09/833,314
Conf. No.: 4353
Filed: April 10, 2001
Title: CANNED FILLED PET FOOD
Art Unit: 1761
Examiner: Steven L. Weinstein
Docket No.: 115808-239

Commissioner for Patents
P.O. Box 1450
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APPELLANTS' REPLY BRIEF

Sir:

I. INTRODUCTION

Appellants submit Appellants' Reply Brief in response to the Examiner's Answer dated October 23, 2007 pursuant to 37 C.F.R. § 41.41(a). Appellants respectfully submit the Examiner's Answer has failed to remedy the deficiencies with respect to the Final Office Action dated September 20, 2006 as noted in Appellants' Appeal Brief filed on June 12, 2007, for at least the reasons set forth below. Accordingly, Appellants respectfully request that the rejections of pending Claims 1-17 be reversed.

II. THE REJECTION OF CLAIMS 1-17 UNDER 35 U.S.C. § 103(a) SHOULD BE REVERSED BECAUSE THE EXAMINER HAS NOT ESTABLISHED A PRIMA FACIE CASE OF OBVIOUSNESS WITH RESPECT TO THE CITED REFERENCES

Appellants respectfully request that the Board reverse the rejections of Claims 1-17 under 35 U.S.C. §103(a) because the Examiner has still failed to provide a sufficient reason why the skilled artisan would combine the cited references to arrive at the present claims. Additionally, Appellants respectfully submit that the Examiner has failed to consider the references as a whole and those portions teaching away from the combination. Moreover, even if properly combinable, Appellants respectfully submit that the cited references fail to disclose or suggest all of the claimed elements of the present invention.

- a. The skilled artisan would have no reason to combine the cited references to arrive at the present claims

Appellants respectfully submit that one having ordinary skill in the art would have no reason to combine the cited references to arrive at the present claims. Moreover, Appellants respectfully submit that even in view of the Examiner's explanation of the rejection, the phrasing of the rejection, and sheer number of references still makes the rejection confusing, the possible permutation of the rejections substantial, and is, therefore, not proper. As a result, the Examiner has not shown why a skilled artisan would have arrive at the present claims.

1. The rejection fails to provide a basis for the suggested combination

In the Examiner's Answer, the Examiner asserts that *May* is, "of course, [] appellant's reason for providing two discernible phases and geometry." See, Examiner's Answer, page 11, lines 7-8. However, Appellants respectfully submit that while the Examiner attempts to provide a reason for Appellants providing two discernible phases and geometry, the Examiner still fails to provide a reason why the skilled artisan would combine the cited references to arrive at the present claims. Even assuming that the rejection includes the three primary references of *Ohba*, *Vickers* and *May*, and is a "perfectly clear" rejection as alleged by the Examiner, the Examiner

fails to provide any reason as to why the skilled artisan would combine the references. For example, *May* is entirely directed to a canned pet food product having two layers (a base and an upper layer). See, *May*, page 2, lines 11-19. *Ohba* relates to vertically and horizontally packed foods containing two or more packed food products to provide a pet food packed in a container so that the pet food may be eaten by pets to the last morsel without satiating the pet with taking the food in repetition. See, *Ohba*, col. 1, lines 14-18; Figures 1 and 2. *Vickers* relates to meat rolls (*i.e.*, butchers meat, such as beef, veal, etc.) rather than canned pet food products, as required by Appellants' invention. See, *Vickers*, col. 1, lines 11-16. The meat roll of *Vickers* combines course particles and finer size particles in visually separate phases, which is said to improve taste, see, *Vickers* at col. 1, line 53 to col. 2, line 63; Figs. 1 and 2.

There exists no reason why the skilled artisan would combine the vertically and horizontally sorted pet food of *Ohba* with the meat rolls of *Vickers*, where *Vickers* fails to even disclose canned pet food products. Further, there exists no reason why the skilled artisan would combine *Vickers* with *May*, where, in *May*, parallel superimposed layers are formed in contrast to an annular-type configuration disclosed in *Vickers*. Moreover, as was clearly demonstrated in Appellants' Appeal Brief, most of the remaining references cited by the Examiner do not even related to food products, let alone pet food products. Therefore, there exists no reason why a skilled artisan, without knowledge of the claimed invention, would have selected the prior art components for combination in the manner claimed.

2. The citation of twenty-one references is too many for a proper obviousness rejection

Further, Appellants respectfully submit that the sheer number of references (21) cited by the Examiner is evidence in and of itself that the invention is not obvious and most likely based solely on a hindsight reconstruction. As the Federal Circuit has noted, the requisite prior art suggestion to combine becomes less plausible when the necessary elements can only be found in a large number of references and "the extent to which such suggestion must be explicit in . . . the references, is decided on the facts of each case, in light of the prior art and its relationship to the applicant's invention." 2-5 Chisum on Patents §5.04 (*quoting In re Gorman*, 933 F.2d 982, 986-87; 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991)). Moreover, the claims must be viewed as a

whole as defined by the claimed invention and not dissected into discrete elements to be analyzed in isolation. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983); *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995). One should not use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d at 1075. (Fed. Cir. 1988). As such, Applicants respectfully submit that the skilled artisan would have no reason to combine the cited references to arrive at the present claims.

In response to Appellants assertion that the number of references (21) provides evidence that the instant invention is unobvious, the Examiner asserts that it could also be argued that the number of references shows the state of the prior art since the rejections “rely on overwhelming evidence that whether a food product is produced for pet or human consumption, the art is replete with examples of providing plural discernible phases having various geometries including the recited shapes.” See, Examiner’s Answer, page 10, lines 4-7. However, Appellants respectfully disagree. Instead, Appellants respectfully assert that the fact that the Examiner was forced to use twenty-one (21) references, the references relating to non-analogous art and each reference having a different intended use, provides support for Appellants repeated assertions that the Examiner is picking and choosing portions of the applied references to selectively piece together teachings of each of the references in an attempt to recreate what the claimed invention discloses.

In the Examiner’s Answer, the Examiner also repeatedly argues that “each reference is argued separately as if it were applied alone, in a vacuum.” See, Examiner’s Answer, page 10, lines 7-8; page 11, lines 9-16. However, Appellants respectfully submit that, to the extent that the cited references are discussed separately, such a discussion is required by the phrasing of the rejection and the sheer number of references cited by the Examiner. Appellants also submit that, to the extent that each cited reference was discussed individually, the discussion of the references was not to address the issue of novelty under 35 U.S.C. §102, but rather to illustrate, in part, the differences between the individual references and reasons why there exists no motivation to combine the references to render the present claims obvious under 35 U.S.C. §103. Appellants respectfully submit that it is the rejection itself that forced Appellants to respond in such a manner.

In sum, Appellants respectfully submit that the Examiner continues to pick and choose selected portions of the cited references to arrive at the present claims. However, when the references are properly considered as a whole, there exists no reason why the skilled artisan would combine the cited references to achieve the claimed invention.

- b. Even if combinable, the cited references fail to disclose or suggest all of the elements of the claimed invention

Appellants respectfully submit that the cited references, alone or in combination, fail to disclose or suggest every element of independent Claims 1, 2, 6 and 9. For example, and as set forth in detail in Appellants' Appeal Brief, the cited references fail to teach or suggest an outer tubular phase which extends from the lower end to the upper end and an inner phase which extends from the lower end to the upper end extending within the outer phase as required, in part, by Claims 1, 2, 6 and 9. Instead, *May* is entirely directed to a canned pet food product having two layers (a base and an upper layer), see, *May*, page 2, lines 11-19; *Ohba* relates to vertically and horizontally packed foods containing two or more packed food products to provide a pet food packed in a container so that the pet food may be eaten by pets to the last morsel without satiating the pet with taking the food in repetition, see, *Ohba*, col. 1, lines 14-18; and *Vickers* relates to meat rolls (*i.e.*, butchers meat, such as beef, veal, etc.) rather than canned pet food products, as required by Appellants' invention (see, *Vickers*, col. 1, lines 11-16). The meat roll of *Vickers* combines course particles and finer size particles in visually separate phases (see, *Vickers*, Figs. 1 and 2) which is said to improve taste (see, *Vickers* at col. 1, line 53 to col. 2, line 63). As such, Appellants respectfully submit that one of the primary references cited by the Examiner teach or suggest an outer tubular phase which extends from the lower end to the upper end and an inner phase which extends from the lower end to the upper end extending within the outer phase as required, in part, by Claims 1, 2, 6 and 9.

The Examiner relies on many other references that teach different cross-sectional shapes of products, many of which are unrelated to canned pet food, to support that it allegedly would have been obvious to use such cross-sectional shapes as a matter of choice or design. See, Office Action dated November 14, 2002, page 3. Accordingly, the Examiner relies on references that disclose a particular cross-sectional shape rather than the invention as a whole, which includes an

outer, tubular phase which extends from the lower end to the upper end of a canned pet food product and an inner phase which extends from the lower end to the upper end of the canned pet food product.

For at least the reasons discussed above, the cited references are not properly combinable and/or fail to disclose or suggest every element of the present claims. Accordingly, Appellants respectfully submit that independent Claims 1, 2, 6 and 9 and Claims 3-5, 7-8 and 10-17 that depend therefrom are novel, nonobvious and distinguishable from the cited references and are in condition for allowance.

III. CONCLUSION


For the foregoing reasons, Appellants respectfully submit that the Examiner's Answer does not remedy the deficiencies noted in Appellants' Appeal Brief with respect to the Final Office Action. Therefore, Appellants respectfully request that the Board of Appeals reverse the obviousness rejections with respect to Claims 1-17.

No fee is due in connection with this Reply Brief. The Director is authorized to charge any fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 115808-239 on the account statement.

Respectfully submitted,

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